

Appl. No. 09/866,823
Amendment and/or Reply
To Office Action Dated
February 17, 2006

2. REMARKS / DISCUSSION OF ISSUES

Claims 1-20 are pending in the application. Claims 1, 9 and 17 are in independent form.

Unless indicated otherwise, claims are amended for non-statutory reasons: to correct one or more informalities, remove figure label number(s), and/or to replace European-style claim phraseology with American-style claim language.

I. Rejections under 35 U.S.C. § 102(e)

1. Claims 17 and 18 were rejected under 35 U.S.C. § 102(e) as being unpatentable in view of *Susskind* (US 2001/0046366 A1).

2. Claims 1 and 9 were rejected under 35 U.S.C. § 102(e) as being unpatentable in view of *Utsunomiya, et al.* (US 2002/0066113 A1)

For at least the reasons set forth herein, it is respectfully submitted that these rejections are improper and should be withdrawn.

A proper rejection for anticipation "...requires, as the first step in the inquiry, that **all the elements** of the claimed invention be described in a single reference." *In re Spada* 15 USPQ2d 1655, 1657 (1990). A necessary corollary to the test of anticipation is that "...the absence from the reference of **any claimed element** negates anticipation." *Kloster-Speedsteel AB v. Crucible, Inc.* 230 USPQ 81, 86 (CAFC 1986).

1. *Susskind* does not disclose a server with memory as claimed in claim 17

Applicants maintain their position set forth in the Reply of February 17, 2006. In addition, Applicants offer the following rebuttal to the present Office Action in furtherance of their position of the patentability of claim 17 and the claims that depend therefrom.

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Claim 17 is drawn to a server adapted for use in a communication network coupled to a plurality of video playback devices. The server comprises a memory for storing a plurality of data files related to the plurality of video playback devices.

In an embodiment described in connection with Fig. 4A, each VDP data file 401-403 includes a disk statistics table that indicates the amount of space that is used and the amount of space that is free for recording programs. Thus, within the resource sharing server 130, each of the VDP data files 401-403 store disk drive space available.

In the reproduced portion of page 2 of the Office Action, the Examiner asserts: The passage cited (paragraph 16, line 6-9) refers to the VRD, which is defined in the application to be a Video Recording Device. From the application (paragraph 29) "a VRD is characterized as having the inherent capability to connect to the internet and communicate with a server. Also it is stated, "that its means of storage is that of a common computer hard disk rather than common video tape." These statements show that the VRD acts as a server containing recorded shows for users to access. The fact that it tracks the "Minutes of Storage Available" (paragraph 35) shows that the device is able to keep track of its internal storage and provide the amount of available storage using the amount of recording time left as a unit of measure. The rejection stands.

The VRD referred to in pghs. [0016] and [0029] of *Susskind* is capable to communicate with a server. The VRD disclosed in paragraph [0029] of *Susskind* includes a common computer hard disk rather than video tape as a means of storage. As such, *Susskind* discloses: a VRD with memory, wherein the VRD is capable of communicating with a server.

By contrast, claim 17 unequivocally recites "...a server comprising a memory for storing a plurality of data files related to said plurality of video playback

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devices..." This is not anticipated by the VRD of *Susskind* which is not a server, but rather only adapted to communicate with the server; nor is the claimed server with a memory anticipated as asserted by the Examiner, because the storage is a part of the VRD, which is not a server.

Therefore, it is respectfully submitted that because at least one element of claim 17 is not disclosed in the portion of the reference relied upon by the Examiner a prima facie case of anticipation has not been established.

For at least the reasons set forth above, it is respectfully submitted that the rejection of claim 17 is improper and should be withdrawn. Moreover, by similar reasoning, it is respectfully submitted that the rejection of claims 18-20 which depend immediately or ultimately from claim 17 is also improper and should be withdrawn.

2. Utsunomiya, et al. does not disclose a second controller

Applicants substantially maintain their position set forth in the Reply of February 17, 2006, but gratefully acknowledge that a more detailed basis for the rejection has been provided. In addition, Applicants offer the following rebuttal to the present Office Action in furtherance of their position of the patentability of claim 1 and the claims that depend therefrom.

Claim 1 is drawn to a video playback device including a first and a second controller. The second controller is capable of determining if sufficient space is available on said disk storage device to store a first television program. Claim 9 is drawn to a method and includes a similar feature.

Applicants respectfully submit that a prima facie case of anticipation has not been made. In the reproduced portion of pages 2 and 3 of the Office Action, the Examiner asserts:

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The applicant argues that figure 2 does not reveal a second controller. Figure 2 shows a timeline of what occurs when one of the two controllers runs out of space while recording a program. The two controllers are shown in figure 1 (parts 3 and 4) as cited in the Office Action (page 3, 5 lines from the bottom of the page). Figure 2 discloses VCR1 executing recording (far left column, 2nd section of words from the top), and that it also monitors available capacity (far left column, next section down). If the available capacity is low (far left column, next section down), the controller sends a request (over the IEEE1394 network) to VCR2 to see if it has available capacity (2nd column from left, 3 sections down). If there is capacity, VCR executes the recording (far right column). The examiner has provided a thorough and complete examination, and the previous rejection stands.

The undersigned agrees that the noted portion of the rejection does provide greater detail than rejection of claims 1 and 9 of the Office Action of February 17, 2006, Applicants maintain that a prima facie case of anticipation has not been made.

Claim 1 is drawn to a video playback device, comprising:

"...a first controller capable of receiving a first program recording command, wherein said first program recording command is operable to cause said first controller to store a first television program on said disk storage device during a first time slot; and

a second controller capable of determining if sufficient space is available on said disk storage device to store said first television program, wherein said disk storage device...."

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Plainly, the video playback device includes two controllers, each performing a particular function. Claim 9 is drawn to a method and includes a similar feature.

The portion of the Office Action reproduced above relies on recorders/players 3 and 4 for the first and second controllers of the video playback device of claim 1. Fig. 6 of *Utsunomiya, et al.* shows a block diagram illustrating a configuration of the playing system of recorder/player 3 or 4. Fig. 6 reveals that the each of the player/recorders 3, 4 include a **single control unit 10**, and **not a first controller and a second controller** as claimed.

For at least the reason set forth above, it is respectfully submitted that the art relied upon in the present rejection failed to disclose at least one feature of claims 1 and 9. Thus, the rejection of claims 1 and 9 are improper and should be withdrawn. Moreover, by similar reasoning, it is respectfully submitted that the rejection of the claims, which depend immediately or ultimately from claims 1 and 9 are also improper and should be withdrawn.

III. Rejection under 35 U.S.C. § 103(a)

Claims 2-8, 10-16 and 19-20 were rejected under 35 U.S.C. § 103(a) in view of *Utsunomiya, et al.*, Susskind and secondary references and tertiary references noted in the Office Action. While in no way conceding the propriety of the rejection, Applicants respectfully submit that because these claims depend immediately or ultimately for claims 1, 9 or 17, the rejection of these dependent claims is improper and should be withdrawn.

IV. Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is

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respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

Respectfully submitted,



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August 14, 2006
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